# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/892,886 | 06/28/2001 | Mikio Aoki | 109952 | 3026 |

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| EXAMINER |
|---|
| WON, MICHAEL YOUNG |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2155 | |

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr><td rowspan="2"><b>Office Action Summary</b></td><td colspan="2">Application No.</td><td>Applicant(s)</td></tr>
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<tr><td></td><td>Examiner</td><td>Art Unit</td><td></td></tr>
<tr><td></td><td>Michael Y Won</td><td>2155</td><td></td></tr>
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*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>30 November 2004</u>.

2a)☒ This action is **FINAL**.      2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-18</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-18</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☒ All   b)☐ Some * c)☐ None of:

   1.☒ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1.      Claims 1 and 9 have been amended and new claims 17 and 18 have been

added.

2.      Claims 1-18 have been examined and are pending with this action.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter, which the applicant regards as his invention.

3.      Claims 1 and 9 rejected under 35 U.S.C. 112, second paragraph, as being

indefinite in that it fails to point out what is included or excluded by the claim language.

This claim is an omnibus type claim.  Claim 1 and 9 recite the limitation "a data format

converting device" and later recite, "the data format*ting* converting device".

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed
> publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.      Claims 17 and 18 rejected under 35 U.S.C. 102(e) as being anticipated by

Lamming et al. (US 5,862,321 A).

As per claims 17 and 18, Lamming teaches of a data output controller that is

communicably connected, via a network, to a portable terminal that is possessed by a

user, issues a data print request, and a plurality of output terminals that is distributed

and installed at various locations to print data, receives a data print request from the

portable terminal, and outputs data regarding the data print request to the output

terminals (see abstract), the data output controller comprising: means for displaying

information on the portable terminal (see Fig.2 and Fig.3(b)); and means for printing the

information via the output terminal in more detail than the portable terminal (inherent:

see Fig.2 and col.6, lines 13-19: document printed is clearly in more detail than what is

displayed in portable device).

## Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.      Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Boswell (US 5,559,933 A) in view of Stewart et al. (US 6,259,405 B1).

## *INDEPENDENT:*

As per claims 1 and 9, Boswell teaches of a data output controller that is

communicably connected, via a network, to a terminal that is possessed by a user and

that issues a data print (output) request, and a plurality of output terminals that is

distributed and installed at various locations to print (output) data, receives a data print

(output) request from the portable terminal, and outputs data regarding the data print

(output) request to the output terminals (see abstract), the data output controller

comprising: a storage device (see col.5, lines 4-8) that stores output terminal

information regarding the output terminals for each of the output terminals (see Fig.19;

col.8, lines 41-43; and col.22, lines 29-30); a selecting device that selects one of the

plurality of output terminals (see col.4, lines 29-33); a data format converting device that

converts the output data into a format according to the output terminal information (see

Fig.20; col.7, lines 11-13; and col.22, lines 41-54); and an output device that outputs the

data regarding the data print (output) request to the output terminal selected by the

selecting device (see col.4, lines 50-57), the data print (output) request including search

data necessary for the selecting device to select the output terminal (see col.4, lines 61-

64), and the selecting device retrieving output terminal information from the storage

device on the basis of the search data contained in the data print (output) request and

on the basis of a capability of the data format converting device (inherent: see col.13,

lines 32-35) so as to select an output terminal considered to be the best suited for the user of the terminal to receive provided output data (see col.5, lines 4-12).

Boswell does not explicitly teach that the user terminal is a portable terminal. Stewart teaches of a portable user terminal (see abstract and Fig.1, #110). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Stewart within the system of Boswell by implementing portable client terminals attached to the data output controller because wireless networking devices (i.e. global positioning systems, personal data assistants, notebooks) have become more readily available (see Stewart: col.1, lines 28-33) and with higher demand for such products and increased communication protocols and capabilities, such an implementation increases scalability and functionality.

## DEPENDENT:

As per claims 2 and 10, Although Boswell teaches of further comprising: the output terminal information including data on an output terminal position to determine the location where the output terminal is installed (see col.7, lines 11-13 and 42-46), the search data including data (see claim 1 and 9 rejections above), he does not explicitly teach of a portable terminal position to determine the position of the portable terminal, and the selecting device retrieving output terminal position data from the storage device on the basis of data on a terminal position contained in the search data, to thereby select an output terminal considered to be the closest distance-wise or time-wise, taking the position of the portable terminal as a reference. Stewart teaches of a portable

terminal position to determine the position of the portable terminal, and the selecting

device retrieving output terminal position data from the storage device on the basis of

data on a terminal position contained in the search data, to thereby select an output

terminal considered to be the closest distance-wise or time-wise, taking the position of

the portable terminal as a reference (see col.3, lines 58-60 and col.3, line 65 to col.4,

line 6). It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to employ the teachings of Stewart within the system of Boswell by

implementing determining the position of the portable terminal, and selecting the closest

output terminal within the data output controller because Stewart teaches that such an

implementation allows the portable devices to send and receive information while at

virtually any location although hard-wired links may not be available without having to

wait to reach an office or other place with appropriate equipment (see col.1, lines 30-36

and 48-54).

As per claims 3 and 11, Boswell teaches of further comprising: the output

terminal information including data on an output terminal position to determine a

location where the output terminal is installed (see col.7, lines 11-13 and 42-46), the

search data including data on a desired providing area that indicates a desired providing

area, which is an approximate place where output data is desired to be provided (see

col.4, lines 29-39), and the selecting device retrieving data on an output terminal

position from the storage device on the basis of the data on a desired providing area

included in the search data to thereby to select an output terminal located in an area

specified by the data on a desired providing area (see col.4, line 50 to col.5, line 12).

As per claims 4 and 12, Boswell does not explicitly teaches of further

comprising: the selecting device not performing search based on the data on a portable

terminal position if the position specified by the data on a portable terminal position is

not included in the area specified by the data on a desired providing area included in the

search data. Stewart teaches of not performing search based on the data on a portable

terminal position if the position specified by the data on a portable terminal position is

not included in the area specified by the data on a desired providing area included in the

search data (see col.26, lines 52-57). It would have been obvious to a person of

ordinary skill in the art at the time the invention was made to employ the teachings of

Stewart within the system of Boswell by implementing not performing search based on

the data on a portable terminal position if the position specified by the data on a

portable terminal position is not included in the area specified by the data on a desired

providing area included in the search data within the data output controller because

such an implementation saves processing power since the data output controller will not

be able to service the request anyways.

As per claims 5 and 13, Boswell teaches of further comprising: the output

terminal information including printing (output) format data indicating a data format that

can be printed (output) by the output terminal among data formats of data regarding the

data print (output) request (see col.20, lines 48-67), the search data including the

printing (output) format data, and the selecting device retrieving printing (output) format

data from the storage device on the basis of the printing (output) format data included in

the search data, and selecting an output terminal associated with the printing format

data (see col.4, line 50 to col.5, line 12).

As per claims 6 and 14, Boswell teaches of further comprising: the output

terminal information including printing (output) specification data indicating the printing

(output) specification of the output terminal (see col.20, lines 48-67), the search data

including the printing (output) specification data, and the selecting device retrieving

printing (output) specification data from the storage device on the basis of printing

(output) specification data included in the search data, and selecting an output terminal

associated with the printing (output) specification data (see col.4, line 50 to col.5, line

12).

As per claims 7 and 15, Boswell teaches of further comprising: the output

terminal information including output terminal identifying data that identifies the output

terminals (see col.7, lines 11-13), the search data including the output terminal

identifying data, and the selecting device retrieving output terminal identifying data from

the storage device solely on the basis of output terminal identifying data included in the

search data, and selecting an output terminal that coincides with the output terminal

identifying data (see col.4, line 50 to col.5, line 12).

As per claims 8 and 16, Boswell teaches of further comprising: the output device

outputting output terminal information corresponding to an output terminal selected by

the selecting device to the portable terminal (see claim 1 and 9 rejection above).

### *Response to Arguments*

6.     Applicant's arguments filed November 30, 2004 have been fully considered but

they are not persuasive.  Although during the interview the examiner could not conclude

that Boswell specifically taught the element of the proposed amendment, after careful

review, Boswell has been found to clearly teach the limitation of a "data format

converting device that converts the output data into a format according to the output

terminal information".  In Figure 20 and col.22, lines 41-54, Boswell teaches of a

translation table employed to "translate character codes sent to a printer".

In view of the response above claims 1-16 remain rejected.  Claims 17 and 18

have been rejected based on a newly discovered prior art (Lamming et al. US 5,862,321

A).

### *Conclusion*

7.     Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action.  Accordingly, **THIS ACTION IS MADE FINAL**.  See MPEP

§ 706.07(a).  Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action.  In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

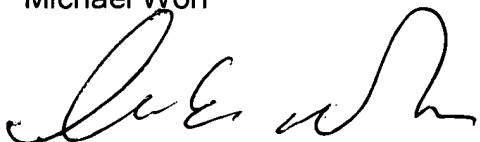shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael Y Won whose telephone number is 571-272-

3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hosain T Alam can be reached on 571-272-3978. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Michael Won

March 18, 2005

BHARAT BAROT
PRIMARY EXAMINER